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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/062,255	04/17/98	MARAVETZ	P B0932/7088RF

PM92/0112

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EXAMINER

VANAMAN, F

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 01/12/00

Handwritten number 14

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/062,255

Applicant(s)
Maravetz et al.

Examiner
Frank Vanaman

Group Art Unit
3611



☒ Responsive to communication(s) filed on Nov 1, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-77 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-77 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Apr 17, 1998 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4,5,7,11

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948 *(substitute form)*

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Election/Restriction

1. Applicant's election without traverse of Species II in Paper No. 13 is acknowledged.
An Office action on the merits follows.

Information Disclosure Statement

2. Numerous references cited in the Information Disclosure Statement filed Aug. 3, 1998 have been indicated as "not considered" as no copies have been provided as set forth in 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed.

Priority

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The second application (which is called a continuing application) must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the continuing application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *In re Ahlbrecht*, 168 USPQ 293 (CCPA 1971).

4. This application repeats a substantial portion of prior Application No. 08/887,530, filed 7/03/1997, and adds and claims additional disclosure not presented in the prior application, such as the embodiments shown in figures 2-31 as described on pages 12-40 of the instant application. Since this application names an inventor or inventors named in the prior application, it may constitute a *continuation-in-part* of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

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5. On page 1, lines 6-8, the reference directed to the Provisional Applications should be amended to read: --This application claims the benefit of U.S. Provisional Application No. 60/---, --, filed --/--/--, and U.S. Provisional Application...--

Drawings

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference numeral 203, in figures 3-14, as described on page 21, line 28: it appears that the reference in the specification should be to numeral --103-- which would be consistent with figures 3-14; in figure 29, the reference character "C" is not shown as described in the specification on page 38, line 20. Correction is required.

Specification

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

8. The incorporation by reference of the material in application 08/887,530, on page 11, is noted, however, this incorporation is unclear, as the instant application has been designated a Continuation of application 08/887,530 and would thusly be expected to contain all the material disclosed in that application.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 23, 24, 28, 29, 45, 46, 48, 51-73 and 76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following terms lack a clear antecedent basis in the claims: "the wedge-shaped cleat" (claim 23, line 1; claim 24, line 1; claim 28, line 1; claim

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29, line 1); "the distance" (claim 23, line 4; claim 29, line 4; claim 48, lines 3 and 4); and "the rider" (claim 54, line 10; claim 55, line 2).

In claims 45 and 46, the scope is unclear: claim 33 recites a snowboard boot, which appears to be directed to a subcombination (i.e., the boot itself), while claims 45 and 46 recite further limitations to the engagement members of the binding, and particular relationships between boot portions and binding portions, which recitation appears to imply a combination of both the boot and the binding.

In claim 51, as amended, the recitation is not entirely clear, in that first and second engagement members are recited, which members 'include' active and compatible engagement members. It is not clear whether there are four different members being recited or whether applicant is suggesting that one of the first or second members is an 'active' member and the other is a 'compatible' member. For the purposes of this office action, the latter condition has been assumed.

In claims 55, 64, 65, 68, and 73, again, the scope is unclear: 54 recites a snowboard binding, implying the subcombination of a binding itself, while claims 55 (lines 3-6), 64, 65, 68 and 73 (the whole of each of the latter four claims) are directed to further particular details of the boot element and particular relationships between the boot and binding, implying a combination of the boot and binding.

Claim 76 lacks a clear antecedent basis for the step (B) recitation as it depends from claim 74 and not from claim 75 which does recite step (B).

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-77 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-63 of copending Application No. 09/062,131. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a snowboard binding system employing a strapless engagement member to include an active latching device, etc.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

13. Claims 1-77 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-48 of copending Application No. 09/062,127. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a snowboard binding system employing a strapless engagement member to include an active latching device, etc.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending

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application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

14. Claims 1-77 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-119 of copending Application No. 09/062,143. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a snowboard binding system employing a strapless engagement member to include an active latching device, etc.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1-5, 7-12, 15, 27, 30-36, 38-42, 45, 47, 49, 51-58, 64, and 68 are rejected under 35 U.S.C. 102(b) as being anticipated by Bader et al. (DE 4,020,873). Bader et al. teach a binding system for attaching a boot (3) having a sole (10-- upper elements 4) to a gliding board (1-- lower elements 2) with a mating engagement system located at least under a toe region (figs. 1, 2) comprising upper wedge-shaped cleat elements (figs. 14, 15 for example), symmetrical about a longitudinal axis, and having narrow free ends and wide base ends, the region between the base and the base end of the wedge (e.g., upper elements, fig 15) providing a shelf which serves to

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engage a pair of lower mating engaging elements (lower elements, figure 15) and resist vertical disengagement of the boot from the binding, the narrow ends of the wedges being narrower than the spacing between the lower elements so as to allow a vertical insertion of the boot in the binding, the engaging causing a deformation of both the lower mating elements and upper wedge elements from an undeformed position associated with the boot being disengaged from the binding to a deformed position associated with the insertion of the boot in the binding, and returning to an undeformed position upon subsequent removal of the boot from the binding, as broadly claimed. Bader et al. further teach a connection which employs both deformation and camming action (e.g., fig. 14) which can be used to facilitate the mutual deformation of the engaging elements (31) to the same degree during both insertion and removal of the boot from the binding.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1-13, 15-22, 25, 27, 30-43, 45, 47, 49, 51-64, 66-72, and 74-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brechet (FR 2,732,230, cited by applicant) in view of Romano (US 5,419,218). Brechet teaches a binding for a snowboard which is provided with an engagement element (5a, 5b) which engages a mating element (11a) located on a toe region of a sole (9) of a boot (4) wherein the boot may be brought directly downward (figs. 4, 5, 6) to engage with the binding. The reference of Brechet fails to teach the mating toe-end connection system as comprising a cleat with chamfered edges and a pair of engaging elements which may be spread apart by the cleat, wherein both engaging elements are adapted to be located under the toe of the boot rather than to the sides.

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Romano teaches a step-in engagement system for connecting a shoe (8) to a pedal (1) comprising a cleat (5) located on a lower shoe surface and having a base with a pair of chamfered sides (12, 10a) presenting an overall wider profile towards the base than away therefrom (note figs. 2, 3), which is provided with a pair of shelves (e.g., 9) which retain a pair of movable retaining loops (48, 48a, fig. 7, 8) which are spring biased (more clearly shown at 19) which have a width and height greater than a fixed stop element (15, also tabs 40) and can bend about the fixed stop element (one sided version in fig. 4), the fixed stop provided to define the lower end of motion for the cleat. The cleat is further provided with a pair of lips (10, 11) at the shoe-facing base surface, which retain the loops in the attached position (fig. 8). The cleat is adapted to be connected to the retaining loops by a downward motion which spreads the retaining loops apart and allows them to close and retain the cleat through the interaction of the loops and the shelves (9) of the cleat, whereby a vertically upward motion is prevented, but a turning motion whereby a heel portion of the shoe is brought in a forward direction (e.g., by pivoting about a vertical axis associated with the cleat- fig. 5) the cleat can be released from the engaging loops.

It would have been obvious to one of ordinary skill in the art at the time of the invention to replace the toe end connectors of the snowboard binding taught by Brechet with the under-shoe step in attachment system taught by Romano, by providing a cleat under the toe end of the boot taught by Brechet and the mating engagement device of Romano on the binding in a location adapted to be positioned below the toe portion for the purpose of decreasing the lateral width of the binding device, and for allowing a simplified insertion-extraction procedure requiring less effort on the part of the operator.

The reference of Brechet as modified by Romano fails to teach that the mating engagement loops and cleat may be used such that the loops and surfaces 10a and 12 are located laterally with respect to one another, rather than longitudinally. In view of the motions of operation remaining the same (i.e., a vertical downward motion to attach and a pivoting motion to release) regardless of the orientation of the cleat and engaging members, it would have been

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obvious to one of ordinary skill in the art at the time of the invention to orient the cleat and cleat engagement mechanism such that the cleat presents lateral and medial chamfered surfaces, for the purpose of decreasing the longitudinal overall length of the front binding element of Brechet as modified by Romano, in order to use a smaller quantity of material.

The reference of Brechet as modified by Romano fails to explicitly teach the free end of the cleat as being narrower than the loop-to-loop distance and the base end as being wider. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the free end of such a width that the free end may easily engage and spread apart the loops (as required for operation of the vertical engagement) and further it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the base end of such a width that the loops are maintained under a degree of tension for the purpose of insuring that the loops exert a reaction force (e.g., towards 10, 11) to prevent an undesired disengagement of the cleat from the loops

Allowable Subject Matter

19. Claims 14, 23, 24, 26, 28, 29, 44, 46, 48, 50, 65, and 73 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims *upon resolution of double patenting and continuation issues*. See below.

20. Please note the pending provisional double patenting rejections which are applied to all pending claims in this application. The claims of the instant application are not presently rejected under 35 USC §112, first paragraph (as lacking an inadequate written disclosure), but applicant is reminded that the instant application claims to be a continuation, *rather than a continuation in part*, of the parent application, 08/887,530, even though a quantity of material disclosed and claimed in the instant application is neither disclosed nor claimed in the parent application. See paragraphs 3 and 4 above.

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Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Beyl (US 4,177,584), Howell (US 4,640,151), Forké (US 4,936,164), Bryne (US 4,942,778), Steinberg (US 5,046,382), Beyl (US 5,131,291), Koehler et al. (US 5,146,644), Bryne (US 5,325,738- note figs. 6a, 6b); Riepl et al. (US 5,577,757), Goss et al. (US 5,695,210), and Ratzek et al. (US 5,697,631) teach boot binding devices of pertinence.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Vanaman whose telephone number is (703) 308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, DC 20231

or faxed to :

(703) 305-3597 or 305-7687 (for formal communications intended for entry;
informal or draft communications may be faxed to the same number but should be
clearly labeled "UNOFFICIAL" or "DRAFT")

FRANK B. VANAMAN
Patent Examiner
Art Unit 3611

January 7, 2000


1/7/00